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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/036,720   | 11/08/2001  | Maren Christensen    | 13487-1             | 5730             |
| 23676  | 7590        | 03/08/2006           | EXAMINER            |                  |
| SHELDON & MAK, INC<br>225 SOUTH LAKE AVENUE<br>9TH FLOOR<br>PASADENA, CA 91101 |             |                      | MOONEYHAM, JANICE A |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3629                |                  |

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                     |                    |  |
|------------------------------|---------------------|--------------------|--|
| <b>Office Action Summary</b> | Application No.     | Applicant(s)       |  |
|                              | 10/036,720          | CHRISTENSEN, MAREN |  |
|                              | Examiner            | Art Unit           |  |
|                              | Janice A. Mooneyham | 3629               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)              | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on November 8, 2001, wherein claims 1-30 are currently pending.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on March 15, 2002 is being considered by the examiner.

#### ***Claim Objections***

3. Claim 9 is objected to because, it is in improper form. Claim 9 appears as a dependent claim. Any claim which is in dependent form but which is so worded that it, in fact, is not a proper dependent claim, as for example it does not include every limitation of the claim on which it depends, will be required to be canceled as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. The applicant may thereupon amend the claim to place it in proper dependent form, or may redraft it as an independent claim, upon payment of any necessary additional fee. See MPEP § 608.01(n). Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable

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one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In particular, the disclosure is nothing more than generalities such as assessing and categorizing various intellectual properties. The applicant uses questionnaires posing questions pertaining to intellectual property and then packages the one or more contract documents with the one or more questionnaires. It is unclear from the disclosure how the computer would be programmed, without undue experimentation, to convert text and essay questions and responses into computer data in order to take into account all of the subjective answers which the process appears to entail. Although the instant specification is replete with generalizations regarding the various factors to be taken into consideration, it is short on any specific direction or guidance as to actually gathering the necessary data, inputting the required data and programming a computer to achieve the desired results. Further, the specification lacks guidance as to how to use the data in maximizing the use of the assets. There is no indication in the specification of how the data is used to plan for all the potential uses of the properties and to maximize the use of the assets. For further examination the claims are interpreted in light of the 35 U.S.C. § 101, and 35 U.S.C. § 112, first paragraph rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has identified the invention in claim 1 as being directed to a system. A system has structure. A questionnaire displayed on a computer is not part of the structure of the apparatus.

Claims 3-6 further define the questionnaire, not the system.

Claim 10 claims a hierarchical tree. This does not appear to define a structure but rather a display.

6. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what applicant is claiming with the following language:

Display step, the management program comprising the steps for;

Packaging the one or more contract documents and the legal questions;

Reviewing the one or more contract documents; and

Acquiring acquired responses to the legal questions; and

Searching the acquired responses.

What is being displayed in this claim? Furthermore, should it not read *the management program performing the steps of ...?*

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
8. Claim 14 is directed to a system wherein a packager operates the packaging module, a reviewer operates the reviewing module and a searcher operates the search module. Claim 15 states that wherein the packager and searcher are the same person. Claims 17 and 18 state that the reviewer is an attorney.

**2105 [R-1] Patentable Subject Matter — Living Subject Matter**

If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.

9. Claim 30 is directed to a signal for transmitting computer information through a computer for causing a computer-based information handling system to perform the steps for managing ownership rights in an intellectual property arising from one or more than one contract documents.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S.

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(15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.

"The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." *Corning v. Burden*, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.

The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary). Other courts have applied similar definitions. See *American Disappearing Bed Co. v. Arnaelsteen*, 182 F. 324, 325 (9th Cir. 1910), cert. denied, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. *Lorillard v. Pons*, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in *American Fruit Growers* when it passed the 1952 Patent Act. A manufacture is also defined as the residual class of product. 1 Chisum, § 1.02[3] (citing W. Robinson, *The Law of Patents for Useful Inventions* 270 (1890)).

A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two



definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

On the other hand, from a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.

Therefore, if applicant is claiming a signal, for this to be statutory, the signal must have a carrier mechanism and functional data that is machine readable.

10. Furthermore, claims 1- 30 do not produce a "concrete" result in the "method and system for managing intellectual property rights or the method for managing ownership rights in intellectual property rights". The results in the present application do not produce concrete results. It is unclear how the present application expresses the use of the questionnaires and how they are used in maximizing the use of the intellectual property assets.

The results of applicant's invention in arriving at a probable success factor for maximizing the use of the intellectual property assets is clearly not the same results found in *State Street Bank & Trust Co. V. Signature Financial group, Inc.*, 149 F 3d

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1371; 47 USPQ 2d 1599 decided by the U.S. Courts of Appeals. "Today we hold the transformation of data representing discrete dollar amounts by a machine through a series of mathematical calculations into a final share price constitutes a practical application of a mathematical algorithm, formula or calculation because it produces a useful, concrete and tangible result, a final share price momentarily fixed for recording and reporting purposes". In the State Street case the "concrete, tangible, and useful results" is allocating money to different funds.

In the *AT&T v. Excel Communications* the useful, concrete, and tangible results is the claimed step of "producing message record for long distance telephone calls, enhanced by addition of Primary Interexchange Carrier (PIC) indicator", the system performs different calculations and the result facilitates differential billing of calls made by the subscriber to long distance service carrier.

The definition of concrete is particular and specific, not general. In the present application, the disclosure is nothing more than generalities as to gathering, assessing and categorizing various intellectual properties. However, the disclosure is short on specifics as to explicitly how the contracts and the questionnaires are packaged or how the pertinent legal questions are generated or what criteria is used to link the data records or what determines how the hierarchical tree is generated which represents the linkage between the data records and the pertinent legal questions. There appears to be many variables and subjective determination made at each step. Furthermore, it is unclear from the disclosure how the computer would be programmed, without undue experimentation, to convert text and essay questions and responses into computer data

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in order to take into account all of these subjective factors which the process appears to entail. Although the instant specification is replete with generalizations regarding the various factors to be taken into consideration, it is short on any specific direction or guidance as to actually gathering the necessary data, inputting the required data and programming a computer to achieve the desired results. Further, the specification lacks guidance as to how to use the data in maximizing the use of the assets.

Therefore, it is clear from the definition of "concrete" and the analysis of the disclosure and the claimed limitations of the present invention mentioned above that the disclosure of the present invention is nothing more than generalizations regarding the various factors to be taken into consideration, and it is short on any particular or specific direction or guidance in achieving the desired results and in providing a concrete result. Consequently, the claims are analyzed based upon the underlying process and thus rejected as being directed to a non-statutory process.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-22 and 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et. al (US 2003/0046307) (hereinafter referred to as Rivette).

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Referring to Claims 1, 3-6, 8 and 20:

Rivette discloses a system for managing intellectual property rights, comprising:  
a central processing unit (Figure 11 (1106));  
a display coupled to the central processing unit (Figure 11 (1122));  
a first memory coupled to the central processing unit (Figure 11 (1108));  
a management program (Figure 4 (314)) comprising a packaging module (Figure 4 (412));

a review module (Figure 4 (416));  
a search module (Figure 4 (410));  
a second, third and fourth memory coupled to the central processing unit (Figure 4 (316) Figure 6 (316)).

Note: Applicant is identifying features of the system by the use of the structure. The intended use of the structure does not distinguish the invention from that of the prior art so long as there is a reasonable belief that the prior art system can perform the limitation.

Referring to Claim 2:

The management program further comprising an approval module (Figure 101 (10116), Figure 102 (10210)).

Referring to Claim 7:

Rivette discloses a system wherein the management module further comprises a privilege access module (Figure 4 (401)).

Claim 9:

Rivette discloses a system comprising a computer readable medium (Figure 11 (1118) [0291]).

Claim 10-19:

A system wherein the packaging module comprises an initialization module (Figure 101) a linkage module (Figure 139), a generation module (Figure 4 (414), a routing module (Figures 4 (418); Figure 101 (10110))

Referring to Claim 21:

Rivette discloses method for managing intellectual property rights in an intellectual property arising from one or more than one contract document, comprising:

packaging the one or more than one contract document and pertinent legal questions comprising one or more than one legal question pertaining to the intellectual property ( Figure 102 (10210);

directing the review of the one or more than one contract documents and acquisition of acquired responses to the pertinent legal questions (Figure 102 (10210), Figure 104-110); and

storing the acquired responses in a database to permit searching the acquired responses (Figure 149(14918)).

Referring to Claim 22 and 26:

Rivette discloses a method wherein the packaging step comprises the steps of:

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initializing a management program and creating data records comprising one or more than one data records having information pertaining to the intellectual property (Figures 1-186);

generating the pertinent legal questions (102 (10210);

linking the data records to the pertinent legal questions (Figure 139 (13910);

displaying a hierarchical tree representing the linkage between the data records and the pertinent legal questions (Figures 18, 65, Figure 157); and

routing the one or more than one contract document, the pertinent legal questions and the data records to the review module (Figure 101 (10110)).

Referring to Claim 27:

Rivitte discloses a method for managing intellectual property rights in an intellectual property arising from one or more than one contract document, comprising:

posing legal questions pertaining to the intellectual property (Figure 102 (10210);

processing, via a central processor via stored management program, wherein the management program performs the steps of packaging the one or more contract documents and the legal questions, reviewing the one or more contract documents and the acquired responses to the legal question and searching the acquired responses; and displaying information pertinent to the intellectual property (Figures 103-110, Figure 176).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 23-25 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette in view of Martin (US 6,330,547) (hereinafter referred to as Martin).

Referring to claims 23 and 24:

Rivette does not disclose wherein the generating step comprises offering choice of rights questionnaires.

However, Martin discloses questionnaires for gathering information pertaining to intellectual property assets (col. 5, lines 63-66).

It would have been obvious to one of ordinary skill in the art to incorporate into the patent information management method of Rivette the questionnaires taught in Martin so as guide the user to provide the complete data necessary to perform an analysis.

Referring to Claim 25:

Martin discloses a method, further comprising, eliciting critical information about ownership rights in the intellectual property (col. 8, lines 52-66).

Referring to Claim 28-30:

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Rivette discloses method for managing ownership rights in an intellectual property arising from one or more contract documents [0897], comprising:

accessing a computer network (Figure 11);

initializing a management program and creating data records and preparing a package (Figures 3-12A)

routing the package for review (Figure 101 (10110)).

Rivette does not disclose wherein the generating step comprises offering choice of rights questionnaires.

However, Martin discloses questionnaires for gathering information pertaining to intellectual property assets (col. 5, lines 63-66).

It would have been obvious to one of ordinary skill in the art to incorporate into the patent information management method of Rivette the questionnaires taught in Martin so as guide the user to provide the complete data necessary to perform any analysis.

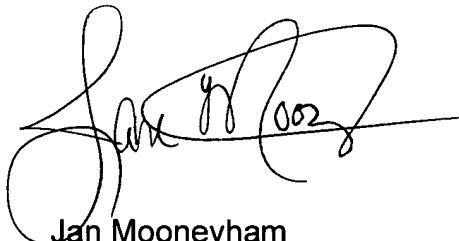


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a stylized flourish extending to the right.

Jan Mooneyham  
Patent Examiner  
Art Unit 3629